

Docket No.
448563/0245

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: **Takahiro Naka, et al.**

Group Art Unit: **2861**

Application No.: **10/811,470**

Examiner: **Anh T.N. Vo**

Filed: **March 26, 2004**

For: **LIQUID CONTAINER**

Date: **November 27, 2006**

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Election of Species requirement in the Office Action dated August 29, 2006, the time for reply to which having been extended for two months from September 29, 2006, to and including November 29, 2006, by the accompanying Petition for Extension of Time, Applicants elect the Species identified by the Examiner as Species 5, which Species was defined by the Office Action as corresponding to Figures 10A-13 and 15.

Applicants respectfully submit that at least claims 1-6, 9, 11, 12, 15, 16, 32, 33, 36, 39, 40, 46, 47 and 60-63 read on elected Species 5.

However, the Office Action is deficient in that it fails to provide a sufficient justification for requiring an Election of Species, as required by M.P.E.P. § 808, which holds:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) **the reasons why there would be a serious burden on the examiner if restriction is not required**, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

(Emphasis added).

Although § 808 speaks of restriction, it is submitted that because following portions of M.P.E.P. § 808 discuss Election of Species requirements, this requirement for the Examiner to establish a searching burden applies equally to an Election of Species Requirement.

The Office Action does not even allege that a search encompassing more than one of Species 1-16 would constitute a serious burden. The Office Action merely states conclusorily "[t]he species are independent or distinct because each species contains its own structural limitations that make them distinct from each other as indicated above" (Office Action, p. 2). This explanation is insufficient - stating conclusorily that Species contain their "own structural limitations that make them distinct from each other " does not identify the alleged source of the searching burden to the Examiner. No particular feature is identified or reason given why a search covering all of those Species would be burdensome.

Applicants further submit that search of the plural Species would not be burdensome because those Species, as defined in the Office Action, share a substantial number of features, all in the context of ink cartridges. For example, Species 1-3, 5-11 and 13 are all directed to ink cartridges having reservoir, buffer chamber, pressurizing and detection structures for regulating ink flow. The other articulated Species also involve aspects of this technology. The features of the different Species are therefore sufficiently similar so that a search for one Species will have a scope that is appropriate for all of the other Species. Consequently, there is no burden to the Examiner that would justify the separate treatment of the different Species of invention.

Applicants also respectfully traverse the formulation of Species in the Office Action. It is clear from the specification and drawings that Figs. 1A-8, 10-13 and 15 are all directed to the same embodiment of the invention. Likewise, it is clear that Figs. 18A-27 and 30-

32C are just different views of the same ink cartridge, and so are also drawn to a single embodiment of the invention.

Lastly, Applicants respectfully traverse the assertion in the Office Action that no claims are generic. It is respectfully submitted that claims 1, 36, 39, 46, 47 and 60 are generic, since those claims each read on more than one of the defined Species (although not necessarily the same plural Species). By way of example only, and not limitation, it will be appreciated that these claims can be read on one or more of Species 4, 7, 8, 9-11, 13,

Consequently, Applicants respectfully request consideration of the additional non-elected Species upon the allowance of at least one of generic claims 1, 36, 39, 46, 47 and 60, in accordance with M.P.E.P. § 806.04(d).

Other than the extension fee authorized in the accompanying Petition for Extension of Time, no fee is believed to be due in connection with the filing of this paper. Nevertheless, if the Commissioner deems any additional fee(s) to be now or hereafter due, the Commissioner is authorized to charge all such fees to Deposit Account No. 19-4709.

Favorable consideration and prompt allowance of this application are respectfully requested. In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

Respectfully submitted,

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